



# UNITED STATES PATENT AND TRADEMARK OFFICE

ET

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,672	03/07/2002	Raymond L. White	316T-003100US	3822
22798	7590	05/03/2006	EXAMINER	
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C. P O BOX 458 ALAMEDA, CA 94501			SIMS, JASON M	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 05/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/092,672	<b>Applicant(s)</b> WHITE ET AL.	
	<b>Examiner</b> Jason M. Sims	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/23/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election of group I, claims 1-8 in the reply filed on 9/25/2003 is acknowledged. Claims 9-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Claim 1 contains improper periods in the parts thereof. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Consideration of the "Computer-Related Inventions" section of the MPEP at section 2106, Part IV, subpart B, has revealed that the instant claims are directed to non-statutory subject matter without requiring performance of a result outside of a computer or representing some type of physical transformation, which is concrete or tangible; or a concrete, tangible, and useful invention; alternatively. Thus, the manipulation of data or conversion of data, in this case determining an incidence of

Art Unit: 1631

disease and its statistical significance is the claimed subject matter without any physical transformation outside of a computer or representation thereof. For example, it is well known that a software program may output results to a computer file and not display it, for example, outside of the computer. The above instant claims also lack statutory subject matter due to being directed to nonfunctional descriptive material since the claims lack performance or control of the physical transformation. The presence of such nonfunctional descriptive material on a computer medium or in a computer system does not prevent this rejection because such nonfunctional descriptive material lacks the implementation of physical functionality regarding such computer elements.

Additionally, applicant(s) may wish to argue that the methods are directed to a practical invention. Consideration of the MPEP at section 2106, Part IV, subpart B, subpart 2, reveals that such a practical invention type requires the production of a useful, concrete, and tangible result, which is reasonably interpreted as at least some physicality of result or representation thereof as required for statutory subject matter. Methods per se as instantly claimed subject matter are reasonably deemed a manipulation of data for such methods, without any physicality, that is, concrete or tangible, requirement. It is noted that the practical invention requirement is directed to a required combination of a useful, concrete, and tangible result, which supports this rejection if only one or more of these criteria fail to be met in the claimed subject matter. It is noted that instantly pending claims, which are reasonably interpreted as requiring physical transformation(s) or representation thereof, are not rejected herein under.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Palsson (US P/N 6524797).

Claim 1, part a and b, are taught by Palsson on page 8, col. 5, lines 52-67 and col. 6, lines 1-39. Palsson discloses that the invention can be used on a variety of populations from a variety of founders, which necessitates a selection process as required by the instant claim.

Claims 1 part b, 2-4, and 7-8 are taught by Palsson on p. 7, col. 4, lines 59-67 and p. 8, col. 5, lines 1-10. In the instant specification a very large family is defined as 100 or more individuals. The cited pages teach a large family as comprising a range of individuals including 100 or more.

Claim 1, part c, is taught by Palsson on p. 7, col. 3, lines 49-67 and col. 4, lines 1-4. Palsson teaches that the invention can be practiced with respect to a selected disease from the Online Mendelian Inheritance in Man Database. Selecting a disease from the database and then selecting a corresponding population clearly links the family to a disease database as required by the instant claim.

Claim 1, part d, is taught by Palsson on p. 7, col. 4, lines 59-67 and p. 8, col. 5, lines 1-10.

Art Unit: 1631

Claim 1, parts e-f, are taught by Palsson on p. 7, col. 4, lines 59-67, p. 8, col. 5, lines 1-10 and lines 39-67, and col. 6, lines 1-39.

Claims 5-6, are taught by Palsson on p. 8, col. 5, lines 52-67 and col. 6, lines 1-5.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is (571)-272-7540.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ardin Marschel can be reached via telephone (571)-272-0718.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571)-273-8300.

Any inquire of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571)-272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER